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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/068,860	02/11/2002	Tadashi Katafuchi	218249US0DIV	2638

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ALEXANDRIA, VA 22314

EXAMINER

JOHNSON, JERRY D

ART UNIT	PAPER NUMBER
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1764

DATE MAILED: 03/21/2003

4

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/068,860

Applicant(s)

KATAFUCHI ET AL.

Examiner

Jerry D. Johnson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-9 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/601,335.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: ____

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6-9 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Zoleski et al.

Zoleski et al., U.S. Patent 4,375,418, teach a lubricating oil composition for use in medium and high speed marine diesel engine crankcases which has a Total Base Number from about 5 to 40 and contains a mineral lubricating oil, an overbased calcium sulfonate, an overbased sulfurized calcium phenate, a zinc dihydrocarbyl dithiophosphate, an alkenylsuccinimide and a friction reducing amount of at least one acyl glycine oxazoline derivative (abstract). The composition comprises from about 0.5 to 10 weight percent of a nitrogen-containing succinimide dispersant as disclosed in column 2, lines 49-63. When the variable x is zero, as specifically disclosed in column 2, line 23, the alkenylsuccinimide is the product of diethylene triamine and succinic acid compound is a molar ratio of 1. The lubricating composition contains an overbased calcium sulfonate having a Total Bas Number ranging from 300 to 450 and is employed in the lubricating oil composition at a concentration ranging from about 0.1 to 5 weight percent (column 2, line 64 to column 3, line 4). Accordingly, Zoleski et al.

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disclose a lubricating composition for marine diesel engines which, if not anticipating the claimed method, would render said method obvious to one having ordinary skill in the art.

Claims 6 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Vinci et al.

Vinci et al., U.S. Patent 5,334,329, teach lubricating oils comprising ashless dispersants (column 1, lines 5-15). In EXAMPLES B-1 and B-2, ashless dispersants which comprise the reaction products of polyisobutenyl succinic anhydride with diethylene triamine or ethylene diamine are disclosed. The lubricating compositions include crankcase lubricating oils for, *inter alias*, marine diesel engines (column 32, lines 18-23).

Claim 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vinci et al. as applied to claims 6 and 7 above, and further in view of Zoleski et al.

While Vinci et al. teach marine diesel lubricants and the addition of other additives (column 28, lines 11-22), Vinci et al. differ from the instant claims in not disclosing the addition of overbased additives.

Zoleski et al., U.S. Patent 4,375,418, teach that lubricating oil compositions for use in medium and high speed marine diesel engine crankcases, in general, have a Total Base Number from about 5 to 40 TBN (column 1, lines 9-17). Accordingly, Zoleski et al. teach a lubricating oil composition for use in medium and high speed marine diesel engine crankcases which has a Total Base Number from about 5 to 40 and contains a mineral lubricating oil, an overbased calcium sulfonate, an overbased sulfurized calcium phenate, a zinc dihydrocarbyl dithiophosphate, an alkenylsuccinimide and a friction reducing amount of at least one acyl glycine oxazoline derivative (abstract). The composition comprises from about 0.5 to 10 weight percent of a nitrogen-containing succinimide dispersant as disclosed in column 2, lines 49-63.

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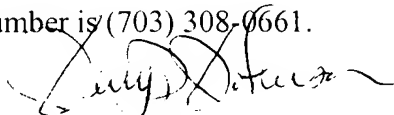
The lubricating composition contains an overbased calcium sulfonate having a Total Base Number ranging from 300 to 450 and is employed in the lubricating oil composition at a concentration ranging from about 0.1 to 5 weight percent (column 2, line 64 to column 3, line 4).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to include an overbased additive as taught by Zoleski et al. in a marine diesel lubricating oil as taught by Vinci et al. because Zoleski et al. teach that lubricating compositions for marine diesel engines generally have a Total Base Number from about 5 to 40 TBN.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerry D. Johnson whose telephone number is (703) 308-2515. The examiner can normally be reached on 6:00-3:30, M-F, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Caldarola can be reached on (703) 308-6824. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-5408 for regular communications and (703) 305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.


Jerry D. Johnson
Primary Examiner
Art Unit 1764

JDJ
March 19, 2003